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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,432

Applicant(s)

STEVENS ET AL. 

Examiner

Vanel Frenel

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-15,55,56,58,60-62 and 64-67 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3,4,6-15,55,56,58,60-62 and 64-67 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 3626

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 05/20/04. Claims 1, 3-4, 6, 7-14, 15, 55-56, 58, 60-62, 64-67 have been amended. Claims 16-54 have been withdrawn. Claims 2, 57, 68-69 have been canceled. Claims 1, 3-4, 6-15, 55-56, 58-62, 64-67 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 and 55-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman (5,544,044) in view of Johnson (4,987,538) and further in view of StellarNet Releases First Internet-Based Claims Verification Product For Worker's Compensation Industry by McCaffrey, Robert (PR Newswire, New York: Nov 11, 1999).

(A) As per the added feature to claim 1, Leatherman and Johnson do not explicitly disclose "a" matching worker's compensation claim number "associated with said data"; "and" "or" "automatically sends" "determining" "to a selected one of a plurality of payer computers".

However, this feature is known in the art, as evidenced by McCaffrey. In particular, McCaffrey suggests “a” matching worker’s compensation claim number “associated with said data”; “and” “or” “automatically sends” “determining” “to a selected one of a plurality of payer computers” (See McCaffrey, Page 2, Paragraphs 1-12).

One of ordinary skill in the art at the time of the invention would have found it obvious to include the feature of McCaffrey within the collective teachings of Leatherman and Johnson with the motivation of providing Web-based system that electronically verifies worker’s compensation claims (See McCaffrey, Page 1, Paragraph 11).

(B) Claim 3 were apparently amended to include the word “provided”. However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(C) Claim 4 were apparently amended to include the words “selected one of said plurality of payer computers”. However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(D) Claim 6 were apparently amended to include the words "the system wherein the software accessed at the provider computer is adapted to use the worker's compensation claim number to produce medical treatment reports including the Worker's Compensation claim number". However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(E) As per claim 7, McCaffrey discloses the system further comprising multiple providers, each having a provider computer, each of the provider computers being operably connected to the Worker's Compensation claim verification system across the Internet (See McCaffrey, Page 1, Paragraph 6).

(F) Claim 8 were apparently amended to include the letter "v" and "c". However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

Art Unit: 3626

(G) Claim 9 were apparently amended to include the letter "v", "c" and the word "said". However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(H) Claim 10 were apparently amended to include the word "said". However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(I) Claim 11 were apparently amended to include the letter "w", "c" and the word "further". However, these changes do not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(J) Claim 12 were apparently amended to include the letter "w", "c" "further", "at least one", "said" and "associated". However, these changes do not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this

Art Unit: 3626

claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(K) Claim 13 were apparently amended to include the letter "w", "c" "is further adapted to", "receive a plurality", "said". However, these changes do not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(L) Claim 14 were apparently amended to include the letter "w" "c". However, this changes does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(M) Claim 15 were apparently amended to include the letter "w", "c" and the words "selected ones of said plurality of payer computers" "provided". However, these changes do not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

Art Unit: 3626

(N) As per the added feature to claim 55, Leatherman and Johnson do not explicitly disclose “workers’ compensation information”, “worker’s compensation”, “wherein said databases are utilized to determine if the subset of the information includes a valid claim number” and “that is transmitted to a payer computer”.

However, this feature is known in the art, as evidenced by McCaffrey. In particular, McCaffrey suggests “workers’ compensation information”, “worker’s compensation”, “wherein said databases are utilized to determine if the subset of the information includes a valid claim number” and “that is transmitted to a payer computer” (See McCaffrey, Page 2, Paragraphs 1-12).

One of ordinary skill in the art at the time of the invention would have found it obvious to include the feature of McCaffrey within the collective teachings of Leatherman and Johnson with the motivation of providing Web-based system that electronically verifies worker’s compensation claims (See McCaffrey, Page 1, Paragraph 11).

(O) As per the added feature to claim 56, Leatherman and Johnson do not explicitly disclose “workers’ compensation information”, “workers’ compensation”, generating an indication” and “fails to include”.

However, this feature is known in the art, as evidenced by McCaffrey. In particular, McCaffrey suggests “workers’ compensation information”, “workers’ compensation”, generating an indication” and “fails to include” (See McCaffrey, Page 2, Paragraphs 1-12).

Art Unit: 3626

One of ordinary skill in the art at the time of the invention would have found it obvious to include the feature of McCaffrey within the collective teachings of Leatherman and Johnson with the motivation of providing Web-based system that electronically verifies worker's compensation claims (See McCaffrey, Page 1, Paragraph 11).

(P) Claim 58 were apparently amended to include the word "message". However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(Q) As per claim 60, McCaffrey discloses the system wherein the electronic signal produced by the indicator is transmitted to the provider of medical services (See McCaffrey, Page 1, Paragraph 6).

(R) Claim 61 were apparently amended to include the words "workers' compensation information" and "workers' compensation". However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(S) Claim 62 were apparently amended to include the words “workers’ compensation information” and “workers’ compensation”. However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(T) Claim 64 were apparently amended to include the words “further comprising the step of: transmitting said”. However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(U) Claim 65 were apparently amended to include the words “further comprising the step of: transmitting said”. However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

Art Unit: 3626

(V) Claim 66 were apparently amended to include the words "workers' compensation information". However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(W) Claim 67 were apparently amended to include the words "workers' compensation information", "workers' compensation", "wherein and "said". However, this change does not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(X) Claims 5, and 59 have not been amended and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

Response to Arguments

4. Applicant's arguments filed on 05/20/04 with respect to claims 1, 3-4, 6-15, 55-56, 58, 60-62, 64-67 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3626

Applicant's argues that Leatherman does not teach verifying workers' compensation.

In response to Applicant argument, Examiner respectfully submits that He relied upon the Leatherman for the teachings of the generic claims processing steps that were recited in Applicant's claimed invention. However, with respect to the specific limitations of processing of Workers' Compensation claims, the Examiner relied upon the collective teachings of Johnson and McCaffrey. Therefore, Applicant arguments directed to the Leatherman reference are non-persuasive.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

Art Unit: 3626

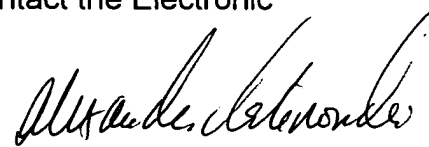
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday-Thursday from 6:30 am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F



ALEXANDER KALINOWSKI
PRIMARY EXAMINER

September 2, 2004